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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/791,789	03/04/2004	Katsuyuki Morii	118396	5208

25944 7590 03/29/2007

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EXAMINER	
CANTELMO, GREGG	
ART UNIT	PAPER NUMBER
1745	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/29/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/791,789	MORII, KATSUYUKI	
	Examiner	Art Unit	
	Gregg Cantelmo	1745	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-22 is/are pending in the application.

4a) Of the above claim(s) 21 and 22 is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-20 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on 04 March 2004 is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date SEE OFFICE ACTION.
4) ☒ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

   I. Claims 1-20, drawn to a coating method, classified in class 427, subclass 115.

   II. Claims 21-22, drawn to devices using the product-by-process of claim 1, classified in class 429, subclass 12.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another and materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the process of Group I can be used as a product in other devices such as gas sensors, electrolyzers, etc.

3. Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper. Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper. Because these inventions are

independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions have acquired a separate status in the art due to their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

4. During a telephone conversation with Ms. Randi Isaacs on March 15, 2007 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-20. Affirmation of this election must be made by applicant in replying to this Office action. Claims 21-22 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Priority

5. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

6. The information disclosure statements filed March 4, 2004; December 12, 2005 and September 9, 2006 have been placed in the application file and the information referred to therein has been considered as to the merits. In order to ascertain the full disclosure of DE 19914680, Applicant is invited to submit a certified translation of this document. Pending full disclosure of this pertinent reference, only the abstract has been considered.

Drawings

7. The drawings received March 4, 2004 are acceptable for examination purposes.

Specification

8. The abstract of the disclosure is objected to because it exceeds 150 words. A 150-word limit has been imposed by the USPTO to conform to PCT applications and Pre-Grant Publications. See 37 CFR 1.72 and rule changes applied thereto. Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-6, 8-11, 13-16 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 6,183,898 (Koschany).

Koschany discloses a method of forming a functional porous layer including a functional material (catalyst) that is supported on a porous material (gas diffusion layer). The method comprises: applying a plurality of solutions or dispersions containing the functional material (catalyst), the catalyst layer being applied in a plurality of steps at different concentrations onto the gas diffusion layer (see col. 5, ll. 41-68). By applying the catalyst material which is applied in a plurality of steps at different concentrations, each mixture application will have an inherent difference in surface tension and thus control the permeation of the catalyst material in the depth direction of the porous layer in accordance with the particular concentration of each distinct application step (as applied to claim 1).

The layer is subsequently dried thereby removing the solvents (col. 5, ll. 35-41 as applied to claim 2).

By applying the various catalyst coatings having different concentrations, the content of the catalyst material varies in the depth direction of the gas diffusion layer (col. 5, ll. 25-35 and ll. 55-65 as applied to claim 3).

The solutions/dispersions are applied to the porous gas diffusion layer (GDL) containing the catalyst material to impregnate the solution/dispersion containing the catalyst material in the gas diffusion layer and this step is repeated for each solution/dispersion of a given concentration to provide a graded catalyst layer in the depth direction of the gas diffusion layer (as discussed above and as discussed in col. 5 of Koschany applied to claim 4).

Each solution has a different concentration of catalyst material (col. 5, ll. 55-65 as applied to claim 5).

The method of Koschany includes applying a first solution/dispersion containing catalyst material to the gas diffusion layer to impregnate the GDL with the first solution/dispersion and then applying at least a second solution/dispersion containing the catalyst material to impregnate the solution/dispersion in the GDL. The amount of catalyst material decreases with increasing distance from the surface of the support material (col. 5, ll. 55-65). Thus there is a higher concentration of catalyst at the surface of the GDL. In order to achieve this gradient, the concentration and surface tension of the second solution must be greater than that of the previous applied solutions in order

to increase the amount of catalyst for each successive application as each additional application draws nearer to the surface of the GDL itself (as applied to claim 6).

The functional porous layer comprises carbon (see Examples and col. 2, ll. 35-55 as applied to claim 8).

The catalyst material includes various carbon-supported noble metals (col. 7, ll. 55-65 and Example 1 as applied to claims 9 and 10).

The catalyzed-GDLs described above are incorporated into the electrodes of a polymer electrolyte fuel cell wherein the fuel cell includes reaction layers and current collectors for each of the anode and cathode with each electrode reaction layer being those described above (see also col. 6, ll. 29-54). These electrodes are separated by an electrolyte membrane (see Examples as applied to claim 11).

Koschany discloses a method of forming a functional porous layer including a functional material (catalyst) that is supported on a porous material (gas diffusion layer). The method comprises: applying a plurality of solutions or dispersions containing the functional material (catalyst), the catalyst layer being applied in a plurality of steps at different concentrations onto the gas diffusion layer (see col. 5, ll. 41-68). By applying the catalyst material which is applied in a plurality of steps at different concentrations, each mixture application will have an inherent difference in surface tension and thus control the permeation of the catalyst material in the depth direction of the porous layer in accordance with the particular concentration of each distinct application step. The catalyzed-GDLs described above are incorporated into the electrodes of a polymer electrolyte fuel cell wherein the fuel cell includes reaction layers and current collectors

for each of the anode and cathode with each electrode reaction layer being those described above (see also col. 6, ll. 29-54). These electrodes are separated by an electrolyte membrane (see Examples as applied to claim 13). The layer is subsequently dried thereby removing the solvents (col. 5, ll. 35-41 as applied to claim 13). The porous layer comprises carbonaceous particles (see paragraph bridging columns 2 and 3 as applied to claim 13)

The reaction layers comprise a catalyst supported on the carbonaceous particles (See Example 1) and the content of the reaction layer material is varied in the depth direction of the GDL (col. 5, ll. 25-65 as applied to claim 14).

The solutions/dispersions are applied to the porous gas diffusion layer (GDL) containing the catalyst material to impregnate the solution/dispersion containing the catalyst material in the gas diffusion layer and this step is repeated for each solution/dispersion of a given concentration to provide a graded catalyst layer in the depth direction of the gas diffusion layer (as discussed above and as discussed in col. 5 of Koschany applied to claim 15).

The method of Koschany includes applying a first solution/dispersion containing catalyst material to the gas diffusion layer to impregnate the GDL with the first solution/dispersion and then applying at least a second solution/dispersion containing the catalyst material to impregnate the solution/dispersion in the GDL. The amount of catalyst material decreases with increasing distance from the surface of the support material (col. 5, ll. 55-65). Thus there is a higher concentration of catalyst at the surface of the GDL. In order to achieve this gradient, the concentration and surface tension of

the second solution must be greater than that of the previous applied solutions in order to increase the amount of catalyst for each successive application as each additional application draws nearer to the surface of the GDL itself (as applied to claims 16 and 20).

The porous layer comprises carbonaceous particles (see paragraph bridging columns 2 and 3) as applied to claim 1) which are applied to a current collector (col. 6, ll. 29-53 as applied to claim 18).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. Claims 7 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koschany in view of U.S. Patent No. 6,542,736 (Sompalli).

The teachings of Koschany have been discussed above and are incorporated herein.

The difference between claims 7 and 17 and Koschany is that Koschany does not teach of forming the different solutions/dispersions using different solvents, however the full disclosure of Koschany is held to reasonably suggest such.

Koschany teaches of varying the amount of catalyst material in the GDL by applying successive catalyst coatings to the GDL wherein the different coatings have different catalyst concentrations. This results in a catalyst gradient formed in the GDL with the greatest catalyst concentration being disposed on the outer surface of the GDL which faces and is in direct contact with the electrolyte membrane (discussed above).

Koschany further recognized that the surface tension of the solutions/dispersions can be adjusted by incorporating additives or detergents into the solution (see col. 3. ll. 8-26).

Sompalli recognized that varying solvent concentrations and solvent materials impacts the degree which a solution will impregnate a porous GDL (see col. 9, ll. 15-45).

Therefore it would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to modify the teachings of Koschany in view of Sompalli by varying the composition of the solvent for the various applied coatings and in particular to add detergents to the solvent for the first applied coatings to regulate the amount of impregnation for each applied catalyst coating and thus maintain the desired gradient catalyst coating to a given GDL.

11. Claims 12 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koschany in view of either U.S. Patent No. 6,153,323 (Colbow) or U.S. Patent No. 6,753,108 (Hampden-Smith).

The teachings of Koschany have been discussed above and are incorporated herein.

The difference between claims 12 and 19 and Koschany is that Koschany does not teach of forming the material with a discharger.

Various coating techniques for applying catalyst layers are known in the art including using ink-jet coating devices (i.e. a discharger). Such methods and systems generally disclosed in Colbow (col. 5, ll. 45-50) or Hampden-Smith (paragraph bridging columns 39 and 40).

Therefore it would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to modify the teachings of Koschany by depositing the catalyst material using a discharger such as an ink-jet coating device since such methods are known techniques for applying catalyst compositions to fuel cell electrodes and provide controlled amounts of a desired coating to a given substrate.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregg Cantelmo whose telephone number is 571-272-1283. The examiner can normally be reached on Monday to Thursday, 8:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Pat Ryan can be reached on 571-272-1292. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Gregg Cantelmo
Primary Examiner
Art Unit 1745

gc
March 15, 2007